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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,455	09/16/1999	NED M SMITH	042390.P6764	8766

7590

06/24/2005

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EXAMINER

FIELDS, COURTNEY D

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/397,455

Applicant(s)

SMITH, NED M

Examiner

Courtney D. Fields

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1,2, and 4-26 are pending.

Response to Arguments

1. Applicant's arguments filed 12 April 2005 have been fully considered but they are not persuasive.
2. Referring to the rejection of claim 1, the Applicant contends and argues that the prior art Grimmer nor Van Oorschot discloses public keys embedded within a software module. The Examiner disagrees and asserts that in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the public keys that are embedded within a software module) are not recited in the rejected claim(s) (See Applicant's Remarks, page 10). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, there is nothing in the claims that clearly point out the distinctions between Van Oorschot and the claimed invention. The claimed invention states "reading from a software module embedding one of a set of key associated with a trusted source". This limitation does not clearly point out that a key is embedded within a software module and that the key is read from the software module. Instead the claim suggests tow distinct operations. First, read from the software module and then embed a key associated with the trusted source. It does not clearly state reading a software module that has embedded within it one of a set of keys.

3. Therefore, claims 1,2, and 4-26 are maintained in view of the reasons above and in view of the reasons below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2, and 4-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimmer (U.S. Patent No. 5,774,552) in view of Van Oorschot (U.S. Patent No. 6,215,872). As per claims 1 and 20, Grimmer teaches a method for determining whether a key is traceable to one of a set of keys associated with a trusted source in Column 5, lines 8-27, Column 6, lines 28-30, and 52-54, determining whether the key is identified in a list of compromised keys in Column 6, lines 28-30, and if the key is not identified or traceable, assigning the key a trusted source in Column 8, lines 20-33. However, Grimmer fails to specifically teach reading from a software module embedding one of a set of key associated with a trusted source. Van Oorschot teaches a method for creating communities of trust in a secure communication system that includes associated authorities (trusted source), users, and a directory. The software program functions as a certification authority sever or a security manager (software module) in which computer system requests made by the users are verified through the security manager. The public keys are embedded within the public key certificates. The public

Art Unit: 2137

key certificate is within the security manager's database. The user's trusted source is associated with the public key within the public key certificate based upon the verification of the security manager as shown in Column 3, lines 57-67, Column 4, lines 1-67, and Column 5, lines 1-22.

Referring to claims 2, 14, and 21, (Grimmer as modified) discloses the claimed limitation of verifying the integrity of a document comprising the key and the list of comprised keys. (See Grimmer, Column 3, lines 25-60)

Referring to claims 4, 16, and 23, (Grimmer as modified) discloses the claimed limitation of tracing the key through a certificate chain to one of the keys in the set of keys. (See Grimmer, Column 5, lines 66-67, Column 6, lines 1-16)

Referring to claim 5, (Grimmer as modified) discloses the claimed limitation of associating a document comprising the key and the set of keys with a software module comprising the set of keys using a hash of the software module in the document. (See Grimmer, Column 3, lines 45-60)

Referring to claim 6, (Grimmer as modified) discloses the claimed limitation in which the document is a manifest signed by the key in Column 4, lines 63-67, Column 5, lines 1-7.

Referring to claim 7, (Grimmer as modified) discloses the claimed limitation of searching the list of compromised keys for the key. (See Grimmer, in Column 7, lines 47-57, Column 8, lines 1-11)

Referring to claims 8, 17, and 24, (Grimmer as modified) discloses the claimed limitation of producing a document comprising an identification of a software module and a list of comprised keys in and digitally signing the document using a key traceable to one of a

Art Unit: 2137

set of keys comprised by the software module. (See Grimmer, Column 3, lines 45-67, Column 4, lines 1-4)

Referring to claims 9, 18, and 25, (Grimmer as modified) discloses the claimed limitation in which the identification of the software module comprises a hash value of the software module. (See Grimmer, Column 5, lines 54-65)

Referring to claims 10, 19, and 26, (Grimmer as modified) discloses the claimed limitation in which the key is traceable to one of the set of keys comprised by the software module by way of a certificate chain. (See Grimmer, Column 5, lines 8-27 and Figure 4)

Referring to claim 11, (Grimmer as modified) discloses the claimed limitation of making the document available on a communication network by which computer systems comprising the software module may read the document. (See Van Oorschot, Column 5, lines 23-41)

Referring to claim 12, (Grimmer as modified) discloses the claimed limitation in which the set of keys is embedded within the software module. (See Van Oorschot, Column 4, lines 11-39)

Referring to claim 13, (Grimmer as modified) discloses a device comprising a processor, machine-readable storage for storing instructions (See Grimmer, Column 7, lines 3-11), determine whether a key is traceable to one of a set of keys associated with a trusted source (See Grimmer, Column 5, lines 8-27), determine whether the key is identified in a list of comprised keys and if the key is not identified as comprised and is

Art Unit: 2137

traceable to one of the keys in the set, assign the key a trusted status. (See Grimmer, Column 8, lines 20-33)

Referring to claim 15, (Grimmer as modified) discloses the claimed limitation of comprising a software module comprising the list of keys. (See Grimmer, Column 4, lines 16-20, Column 6, lines 17-27)

Referring to claim 22, (Grimmer as modified) discloses the claimed limitation of reading from a software module embedding the set of keys. (See Van Oorschot, in Column 4, lines 11-39)

Therefore it would have obvious to a person of ordinary skill in the art, at the time the invention was made to combine Grimmer's trusted source method and Oorschot's software module embedding keys method. Furthermore, one of ordinary skill in the art would have been motivated to this because this will provided trust in secure communication systems, enabling users to obtain trust in public keys of other users and other trusted sources.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2137

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CDF

cdf

June 15, 2005

Matthew D. Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137